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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/503,478	02/14/2000	Noriaki Tanaka	862.C1821	6658

5514 7590 08/29/2003

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NEW YORK, NY 10112

EXAMINER
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JONES, DAVID

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/29/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/503,478

Applicant(s)

TANAKA, NORIAKI

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 February 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig. 10, #S202. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-13, 15-21, 23-28, and 30 rejected under 35 U.S.C. 102(b) as being anticipated by Boswell, U.S. Patent 5,559,933.

Regarding claim 1, Boswell discloses a printing system (Fig. 3) for performing printing by a plurality of printers (Fig. 3, items 120, 122, 124, 126, 128, 130, 132) in response to print requests from a plurality of terminal (Fig. 3, items 112, 114, 116, 118) devices connected via a network, comprising: specifying means (column 13, lines 19-31, Fig. 3, #278) for specifying a terminal device, in which image information to be printed has been stored, in accordance with print requests from said plurality of terminal devices; and first designating means (column 13,

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lines 19-31) for instructing a terminal device that has been specified by said specifying means to transfer the image information to a printer.

Regarding claim 2, Boswell discloses a system that further comprises a second designating means for designating a printer that is to print image information; wherein said first designating means instructs transfer of the image information in dependence upon mode of connection between the printer designated by said second designating means and the terminal device storing the image information (column 13, lines 1-18).

Regarding claim 3, Boswell discloses a system wherein said first designating means instructs transfer of the image information in dependence upon whether said terminal device and printer are connected locally or via a network (column 13, lines 9-18).

Regarding claim 4, Boswell discloses a system wherein said specifying means includes a management database for managing image information as image file names; said specifying means specifying a terminal device, which is storing image information to be printed, based upon an image file name that has been registered in said management database (column 9, lines 50-67, column 10, lines 1-5).

Regarding claim 5, Boswell discloses a system wherein the image file name is a combination of a unique file name in the terminal device storing the image information and an identifier of this terminal device (column 16, lines 51-60).

Regarding claim 6, Boswell discloses a system that further comprise a means to total a information for statistical analyzation based upon attribute information in said management database (column 9, lines 14-44).

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Regarding claim 8, Boswell discloses a method of controlling a printing system (fig. 3) for performing printing by a plurality of printers (fig. 3, items 120, 122, 124, 126, 128, 130, 132) in response to print requests from a plurality of terminal devices (Fig. 3, items 112, 114, 116, 118) connected via a network, comprising: a specifying step of specifying a terminal device (column 13, lines 19-31, Fig. 3, #278), in which image information to be printed has been stored, in accordance with print requests from the plurality of terminal devices; and a first designating step (column 13, lines 19-31) of instructing a terminal device that has been specified at said specifying step to transfer the image information to a printer.

Regarding claim 9, Boswell discloses a method that further comprises a second designating step of designating a printer that is to print image information; wherein said first designating step instructs transfer of the image information in dependence upon mode of connection between the printer designated at said second designating step and the terminal device storing the image information (column 13, lines 1-18).

Regarding claim 10, Boswell discloses a method wherein said first designating step instructs transfer of the image information in dependence upon whether said terminal device and printer are connected locally or via a network (column 13, lines 9-18).

Regarding claim 11, Boswell discloses a method wherein said specifying step specifies a terminal device, which is storing image information to be printed, based upon an image file name that has been registered in a management database for managing image information as image file names (column 16, lines 51-60).

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Regarding claim 12, Boswell discloses a method wherein the image file name (column 16, lines 51-60) is a combination of a unique file name in the terminal device storing the image information and an identifier of this terminal device (column 12, lines 44-64).

Regarding claim 13, Boswell discloses a method further comprises a totalization step of totalizing statistical information based upon attribute information in said management database (column 9, lines 14-44).

Regarding claim 15, Boswell discloses a computer-readable storage medium storing program code of a method of controlling a printing system (column 15, lines 54-63; fig. 7, #290), comprising: code of a specifying step of specifying a terminal device, in which image information to be printed has been stored, in accordance with print requests from a plurality of terminal devices; and a designating step of instructing a specified terminal device to transfer the image information to a printer.

Regarding claim 16, Boswell discloses a printing system having a plurality of image storage devices (fig. 3, items 112, 114, 116, 118) connected via a network and a plurality of printers (fig. 3, 120, 122, 124, 126, 128, 130, 132), said printing system comprising: specifying means (column 13, 1-18) for specifying an image storage device, in which image information to be printed has been stored, in accordance with print requests from terminal devices connected via the network; and first designating means for instructing that the image information, which has been stored in an image storage device specified by said specifying means, is transferred to a printer.

Regarding claim 17, Boswell discloses a system that further comprises a second designating (column 13, lines 1-18) means for designating a printer that is to print image

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information; where in said first designating means instructs that the image information be transferred to the printer designated by said second designating means.

Regarding claim 18, arguments are analogous for those presented for claim 3, are applicable.

Regarding claim 19, Boswell discloses a system wherein said specifying means includes a management database (column 9, lines 50-67, column 10, lines 1-5) for managing image information as image file names; said specifying means specifying an image storage device, which is storing image information to be printed, based upon an image file name that has been registered in said management database.

Regarding claim 20, arguments are analogous for those presented for claim 5, are applicable.

Regarding claim 21, arguments are analogous for those presented for claim 6, are applicable.

Regarding claim 23, arguments are analogous for those presented for claim 1, are applicable.

Regarding claim 24, Boswell discloses a method that further with a second designating step (column 13, 1-18) of designating a printer that is to print image information; wherein said first designating step instructs that the image information be transferred to the printer designated at said second designating step.

Regarding claim 25, arguments are analogous for those presented for claim 3, are applicable.

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Regarding claim 26, arguments are analogous for those presented for claim 4, are applicable.

Regarding claim 27, arguments are analogous for those presented for claim 5, are applicable.

Regarding claim 28, arguments are analogous for those presented for claim 6, are applicable.

Regarding claim 30, arguments are analogous for those presented for claim 15, are applicable.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 14, 22, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Boswell as applied to claims 1-6, 8-13, 15-21, 23-28, and 30 above, and further in view of Kraslavsky et al. U.S. Patent 5,537,626.

Regarding claims 7, 14, 22, and 29, Boswell discloses a statistical review based upon attribute information in said management database, Boswell states that the DEPCON allows for logging of records for cost accounting, print job tracking, or statistical reports, but does not detail the explicit attributes contained in the statistical information (column 9, lines 41-45).

Kraslavsky et al. discloses the attribute information that can be included in the statistical information (column 14, lines 49-67), wherein the attribute information includes identifiers,



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image file names, number of pages to be printed, and printing date, therefore it would have been obvious to one skilled in the art at the time the invention was made to include the information disclosed by Kraslavasky et al. in the statistical information disclosed by Boswell for a complete analysis of operations or for billing purposes.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (6:30am - 3:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

dlj

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

U.S. DEPARTMENT OF COMMERCE

PATENT AND TRADEMARK OFFICE

# EXAMINER'S CASE ACTION WORKSHEET

Application No. 09/503,478		Legal Instrument Examiner
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CHECK TYPE OF ACTION

DATE OF COUNT

<input checked="" type="checkbox"/> Non-Final Rejection	<input type="checkbox"/> Restriction/Election Only	<input type="checkbox"/> Final Rejection
<input type="checkbox"/> Ex Parte Quayle	<input type="checkbox"/> Allowance	<input type="checkbox"/> Advisory Action
<input type="checkbox"/> Examiner's Answer	<input type="checkbox"/> Reply Brief Noted	<input type="checkbox"/> Non-Entry of Reply Brief
<input type="checkbox"/> Defective Notice of Appeal	<input type="checkbox"/> Interference Disposal SPE _____ (Approval for Disposal)	<input type="checkbox"/> Suspension (Examiner-Initiated) SPE _____ (initial)
<input type="checkbox"/> Defective Appeal Brief	<input type="checkbox"/> SIR Disposal (use only after FAOM)	<input type="checkbox"/> Supplemental Examiner's Amendment
<input type="checkbox"/> Miscellaneous Office Letter (With Shortened Statutory Period Set)	<input type="checkbox"/> Notice of Non-Responsive Amendment (With One Month Time Period set)	<input type="checkbox"/> Miscellaneous Office Letter (No Response Period Set)
<input type="checkbox"/> Abandonment after BPAI Decision	<input type="checkbox"/> Supplemental Action (excluding Examiner's Answer)	<input type="checkbox"/> Response to Rule 312 Amendment
<input type="checkbox"/> Letter Restarting Period for Response (e.g., Missing References)	<input type="checkbox"/> Interview Summary	<input type="checkbox"/> Authorization to Change Previous Office Action SPE: _____ (Initial)
<input type="checkbox"/> Abandonment	<input type="checkbox"/> Express Abandonment Date: _____	<input type="checkbox"/> Other Specify: _____

Examiner's Name: David L Jones

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